

REMARKS**35 USC § 102**

Claims 1-20 were rejected under 35 USC § 102(b) as being anticipated by Miljkovic (U.S. Pat. No. 6,080,425) and alleged that elements not literally present in previously pending claims would be inherently present in the Miljkovic reference.

The Examiner failed to provide the applicant with any rationale or evidence tending to show inherency. The fact that a certain result or characteristic **may occur or be present** in the prior art **is not sufficient** to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence '**must make clear that the missing descriptive matter is necessarily present** in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, **may not be established by probabilities or possibilities**. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

Nevertheless, the applicant amended the presently pending claims to even more clearly point out the difference over the '425 reference. Claims 1 and 13 as amended herein expressly require an "...inhibitor that is **recognized as inhibiting a collagenase activity...**" and a step of "...**recognizing that a boron-containing compound has inhibitory activity** towards a collagenase...".

There is no recognition in the '425 reference that various boron-containing compounds exhibit inhibitory activity against a collagenase. On the contrary, **Miljkovic specifically teaches use of his compounds to increase synthesis of collagen**. It should be specifically pointed out that there is a substantial difference between inhibition of a degradation reaction and a stimulation of synthesis. Among other things, specific stimulation of synthesis will promote an increase on a prolin : leucin ratio (as the data in Figure 4-6 in the '425 reference clearly suggest), while an inhibition of a degradation should result in steady, or even decreasing prolin : leucin ratio. Therefore, **Miljkovic clearly failed to recognize that specific boron-containing compounds exhibit collagenase inhibitory activity**, an element specifically required in the

presently amended claims. Consequently, amended claims 1 and 13, and claims 2-12 and 14-20 are not anticipated.

Claims 1-20 are also not obvious over Miljkovic as the '425 reference clearly teaches away, if not even against the subject matter as presently claimed (*supra*). Furthermore, even if the Examiner would hold claims 1-20 as being obvious over Miljkovic, previous filing of a terminal disclaimer over the '425 patent should render this rejection moot.

ATTACHED MARKED-UP VERSION OF CHANGES

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE".

REQUEST FOR ALLOWANCE

Claims 1-20 are pending in this application. The applicant requests allowance of all pending claims.

Respectfully submitted,

Rutan & Tucker, LLP

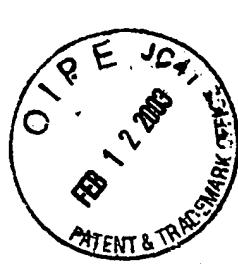
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VERSIONS WITH MARKING TO SHOW CHANGES MADE

In the Claims

1. (Amended) A cosmetic preparation comprising [a collagenase] an inhibitor that is recognized as inhibiting a collagenase activity [at a concentration effective to reduce a collagenase activity] in a skin when the inhibitor is applied to the skin, wherein the [collagenase] inhibitor comprises boron.

13. (Amended) A method of reducing collagenase activity in skin, comprising:
recognizing that a boron-containing compound has inhibitory activity towards a collagenase;
including into [providing] a cosmetic preparation [comprising a collagenase inhibitor] the boron-containing compound at a concentration effective to reduce a collagenase activity in a skin [, wherein the collagenase inhibitor comprises boron]; and applying the preparation to the skin.